

Remarks

Upon entry of the foregoing amendment, claims 1, 11, 13, and 24-98 are pending in the application.

The title has been amended to more precisely reflect the presently claimed invention. Claims 24-98 have been added to more particularly point out and distinctly claim the subject matter Applicants regard as the invention. Support for the new claims is found throughout the specification as filed.

More particularly, support for new claims 24-98 can be found, for example, at page 34, line 31 to page 36, line 28; pages 56-61; page 75, line 5 to page 78, line 24; page 83, line 16 to page 110, line 5; page 146, line 14 to page 147, line 3; Example 10; Example 31; and Claims 11 and 13, as originally filed.

No new matter has been introduced.

The Restriction Requirement

Claims 1-10, 12, and 14-23 have been canceled without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter encompassed by all canceled claims in one or more divisional or continuation applications.

The Examiner has required an election under 35 U.S.C. § 121 of one of ten groups cast by the Examiner. The Examiner contends that the individual groupings are distinct, each from each other.

Applicants respectfully point out that new claims 24-98 fall within the ambit of Group IV as cast by the Examiner.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the invention of Group IV, drawn to antibodies to polypeptides of the invention (*e.g.*, SEQ ID NO:68 and the HPMBQ91 cDNA contained in ATCC Deposit No. 97922), represented by new claims 24-98.

With respect to the Examiner's division of the invention into ten groups and the reasons stated therefor, Applicants respectfully traverse.

Applicants point out, that even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". (*See* M.P.E.P. § 803.) In the present situation, the Examiner has failed to make such a showing.

Applicants submit that a search of polynucleotide claims of the invention would provide useful information for examining claims directed to both polynucleotides and the polypeptides encoded by these polynucleotides. In certain claims this is especially true because the polynucleotide sequence of these claims is defined in part by the polypeptide that the polynucleotide sequence encodes. Further, Applicants point out that, in many if not most publications, where a published nucleotide sequence is an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence of the encoded polypeptide.

Similarly, a search of the polypeptide claims of the invention would clearly provide useful information for the examination of claims directed to antibodies either produced in response to or having affinity for the subject polypeptides. This is because antibodies are frequently defined by the antigens that they are produced in response to and the epitopes to which they bind. Moreover, in many publications where an antibody is described, the antigen that it was produced in response to is also described.

Further, searches of publications directed to polynucleotides and the use of those polynucleotides would clearly be overlapping. This is so because in many, if not most, publications which describe polynucleotides, these molecules are described by their function, characterization and/or expression profile. Thus, a search of polynucleotide claims would also provide the Examiner with art directed to the manner in which the claimed polynucleotides could be used in diagnostic and therapeutic indications.

Further, searches of publications directed to polypeptides and the use of those polypeptides would clearly be overlapping. This is so because in many, if not most, publications which describe polypeptides, these molecules are described by their function. Thus, a search of polypeptide claims would also provide the Examiner with art directed to the manner in which the claimed polypeptides could be used to treat disease states.

In view of the above, Applicants submit that the searches for polynucleotides, polypeptides, antibodies, and methods of diagnosing and treating disease states using the nucleic acids, proteins and antibodies of the subject invention would clearly be overlapping. Accordingly, Applicants request that the Examiner reconsider and withdraw the restriction requirement and examine the subject matter of Groups I-X together in the present application.


Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.121 that is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

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Respectfully submitted,

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